UNITED STATES PATENT AND TRADEMARK OFFICE

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FISH & RICHARDSON, PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER
SAMS, MATTHEW C

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/809,922
Filing Date: March 24, 2004
Appellant(s): MACALUSO, ANTHONY G.

_____

Hwa C. Lee
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/20/2009 appealing from the Office action

mailed 10/8/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

A substantially correct copy of appealed claim 28 appears on page 20 of the Appendix to the Appellant's brief. The minor errors are as follows: "advertisements-has" should read "advertisements has" and "for-the" should read "for the".

(8) Evidence Relied Upon

US-6,665,533   Sakoda   12/2003

US 2003/0179229	Van Erlach et al.	9-2003
US 2002/0166127	Hamano et al.	11-2002
US 2005/0131837	Sanctis et al.	6-2005 (Provisonal. App. Dated 12-2003)
US-5,913,040	Rakavy et al.	6-1999
US 2002/0128908	Levin et al.	9-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4, 6, 7, 17, 21 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakoda (US-6,665,533) in view of Van Erlach et al. (US 2003/0179229 hereinafter, Van Erlach).

Regarding claim 1, Sakoda teaches a method for advertising (Abstract, Col. 2 lines 20-23 and Col. 9 line 59 through Col. 10 line 4) on a mobile device (Col. 4 lines 48-52), the method comprising:

storing a plurality of advertisements on a mobile device; (Col. 10 lines 22-27 and Col. 11 lines 13-16)

initiating a wireless communication involving the mobile device; (Fig. 1, Fig. 7 [Activate Command], Col. 9 line 65 through Col. 10 line 4 and Col. 10 lines 10-16)

determining a time required to complete the wireless communication. (Col. 8 lines 55-61)

Sakoda teaches displaying to the user the time remaining (*i.e.* waiting time) until

a requested wireless communication is completed (Col. 8 lines 55-58), displaying advertisements during the waiting time (Col. 8 lines 59-61), the display of an advertisement ends as soon as the requested wireless communication has been received (Col. 8 lines 62-67) and includes that a "variety of methods can be considered for selecting an advertisement to be displayed from such a plurality of advertisements" (Col. 10 lines 55-57), but differs from the claimed invention by not explicitly reciting selecting one of the stored advertisements to present on the mobile device during at least a portion of the wireless communication if the determined time is longer than a threshold time.

In an analogous art, Van Erlach teaches a method and system for selecting content or advertisements (Page 1 [0009]) to provide to a user interface of a mobile device (Page 1 [0007]) that includes selecting an advertisement based on the time available for an advertisement. (Page 2 [0011]) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to be motivated to implement the method displaying advertisements of Sakoda after modifying it to incorporate the selecting of advertisements due to time constraints of Van Erlach since Sakoda is open to a variety of display priorities and it is common sense that if only part of an advertisement is seen because there is not enough time to view it in the entirety, the advertisement might not be effective.

Regarding claim 2, Sakoda in view of Van Erlach teaches downloading the advertisement to the mobile device over a wireless interface. (Sakoda Col. 3 lines 11-23 & Col. 5 lines 28-33)

Regarding claim 3, Sakoda in view of Van Erlach teaches the wireless communication comprises download of data to the mobile device. (Sakoda Col. 5 lines 28-33 and Col. 8 lines 51-61)

Regarding claim 4, Sakoda in view of Van Erlach teaches the download of data comprises data used by an application running on the mobile device. (Sakoda Col. 3 lines 11-23 "control means")

Regarding claim 6, Sakoda in view of Van Erlach teaches the download of data content (Sakoda Col. 7 lines 9-13) and it is obvious and well known to one of ordinary skill in the art that a download of data/information can comprise an application file, an HTML web page, a text document, an executable file or any other type of content. (Sakoda Col. 7 lines 9-13)

Regarding claim 7, Sakoda in view of Van Erlach teaches presenting the advertisement on the mobile device comprises presenting the advertisement during a delay period, with the delay period representing a time during which the download of data occurs. (Col. 8 lines 51-61)

Regarding claim 17, the limitations of claim 17 are rejected as being the same reason set forth above in claim 1.

Regarding claim 21, the limitations of claim 21 are rejected as being the same reason set forth above in claim 4.

Regarding claim 34, Sakoda teaches a method of advertising on a mobile device, the method comprising:

storing a plurality of advertisements on a mobile device; (Sakoda Col. 10 lines

22-27 and Col. 11 lines 13-16)

initiating a wireless communication session involving the mobile device; (Sakoda Fig. 1, Fig. 7 [Activate Command], Col. 9 line 65 through Col. 10 line 4 and Col. 10 lines 10-16)

determining a time required to complete the wireless communication, the time representing a period of delay in the wireless communication session. (Sakoda Col. 8 lines 55-61)

Sakoda teaches displaying to the user the time remaining (*i.e.* waiting time) until a requested wireless communication is completed (Col. 8 lines 55-58), displaying advertisements during the waiting time (Col. 8 lines 59-61), the display of an advertisement ends as soon as the requested wireless communication has been received (Col. 8 lines 62-67), including a "variety of methods can be considered for selecting an advertisement to be displayed from such a plurality of advertisements" (Col. 10 lines 55-57) and differing "successively viewed advertisements" (Col. 9 lines 9-13), but differs from the claimed invention by not explicitly reciting presenting a rotation of the stored advertisements on the mobile device during the period of delay in the wireless communication session if the determined time is longer than a threshold time.

In an analogous art, Van Erlach teaches a method and system for selecting content or advertisements (Page 1 [0009]) to provide to a user interface of a mobile device (Page 1 [0007]) that includes selecting an advertisement based on the time available for an advertisement. (Page 2 [0011]) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to be motivated to implement

the method displaying advertisements of Sakoda after modifying it to incorporate the selecting of advertisements due to time constraints of Van Erlach since Sakoda welcomes the idea of implementing a variety of methods for selecting advertisement display priorities (Sakoda Col. 11 lines 9-16) and explicitly teaches differing successively viewed advertisements (Sakoda Col. 9 lines 9-13), it is well within the scope of one of ordinary skill to realize that if the waiting time is much longer than any one stored advertisement, in order to keep the user entertained for the waiting time, to continue to show different advertisements, as suggested by Sakoda. (Col. 9 lines 9-13)

Regarding claim 35, the limitations of claim 35 are rejected as being the same reason set forth above in claim 2.

Regarding claim 36, the limitations of claim 36 are rejected as being the same reason set forth above in claim 7.

Claims 8-13, 16, 18-20, 26-33 and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakoda in view of Van Erlach as applied to claim 1 above, and further in view of Hamano et al. (US 2002/0166127 hereafter, Hamano).

Regarding claim 8, Sakoda in view of Van Erlach teaches the limitations of claim 1 above including keeping track of the date an advertisement was received (Col. 7 lines 46-51), but differs from the claimed invention by not explicitly reciting the determining that the stored advertisement has expired and sending a notification of the expiration in response to the expiration determination.

In an analogous art, Hamano teaches a system and method for providing

advertisements to a wireless terminal that includes determining if the advertisement has
expired and updating the advertisement if required. (Fig. 2, Page 2 [0028] and Page 3
[0033]) At the time the invention was made, it would have been obvious to one of
ordinary skill in the art to implement the method of advertising of Sakoda in view of Van
Erlach after modifying it to incorporate the checking for advertisement expiration dates
and updating the advertisements if required of Hamano. One of ordinary skill in the art
would have been motivated to do this since it allows the viewer to see the most current
and accurate advertisement available and eliminates false hopes that can occur if an
expired ad is viewed. (Hamano Page 3 [0033])

Regarding claim 9, Sakoda in view of Van Erlach and Hamano teaches the
notification comprises a request for a new advertisement. (Hamano Page 2 [0028] and
Fig. 2)

Regarding claim 10, Sakoda in view of Van Erlach and Hamano teaches the
stored advertisement has expired based on at least one of an expiration time and a
number of times the advertisement is presented. (Hamano Page 2 [0028] and Page 3
[0033])

Regarding claim 11, Sakoda in view of Van Erlach and Hamano teaches the
notification comprises a request for a new expiration time. (Hamano Page 3 [0032-
0033])

Regarding claim 12, Sakoda in view of Van Erlach and Hamano teaches
receiving a new advertisement in response to the notification. (Hamano Fig. 2, Page 2
[0028] and Page 3 [0032-0033])

Regarding claim 13, Sakoda in view of Van Erlach and Hamano teaches receiving at least one of an expiration time for the new advertisement and an assigned number of times to present the new advertisement. (Hamano Fig. 2, Page 2 [0028], Page 3 [0032-0033] and Page 6 [Claim 12])

Regarding claim 16, Sakoda in view of Van Erlach and Hamano teaches monitoring at least one of a number of times the stored advertisement is presented and a frequency that the stored advertisement is presented. (Sakoda Col. 7 lines 46-51 & Hamano Page 6 [Claim 12])

Regarding claim 18, the limitations of claim 18 are rejected as being the same reason set forth above in claim 8.

Regarding claim 19, the limitations of claim 19 are rejected as being the same reason set forth above in claim 10.

Regarding claim 20, the limitations of claim 20 are rejected as being the same reason set forth above in claims 9 and 11.

Regarding claim 26, Sakoda in view of Van Erlach and Hamano teaches a communications system (Sakoda Fig. 1, Van Erlach Fig. 1, and Hamano Fig. 1), comprising:

a wireless telecommunications network operable to support communications with mobile devices; (Sakoda Fig. 1 [20])

a central advertising server (Sakoda Fig. 1 [10] and Col. 5 lines 28-33) in communication with the wireless telecommunication network (Sakoda Fig. 1 communication lines between 10 & 20]) and adapted to store advertisements for

presentation on mobile devices during wireless data communications that cause a delay on the mobile devices (Sakoda Col. 8 lines 51-61), wherein the central advertising server is further adapted to:

receive a request for a new advertisement from an advertising application on a mobile device storing one or more advertisements; (Hamano Page 2 [0028] and Fig. 2)

receive information related to one of the stored advertisements from the advertising application on the mobile device; (Sakoda Col. 7 lines 46-51 and 65-67)

update a database record associated with the one of the stored advertisements based on the received information; (Sakoda Col. 7 lines 46-51 and 65-67)

determine whether at least one new advertisement is available; (Hamano Page 2 [0028] and Page 3 [0033]) and

transmit a selected new advertisement to the mobile device if at least one new advertisement is available (Hamano Page 3 [0032-0033]), wherein the advertising application on a mobile device presents the new advertisement during the delay if the delay is longer than a threshold time. (Van Erlach Page 2 [0011])

Regarding claim 27, Sakoda in view of Van Erlach and Hamano teaches receiving responses from the mobile terminals regarding feedback information about how may times advertisements were displayed (Sakoda Col. 7 lines 46-51 & 65-67), which obviously motivates the service provider to create, maintain and analyze statistical information regarding expected fees and advertisement views/success rates

of advertisements because an advertiser's views/success rate would be the best selling point for getting new advertisers. (Sakoda Col. 7 lines 65-67)

Regarding claim 28, Sakoda in view of Van Erlach and Hamano teaches the statistics relating to the one of the stored advertisements include at least one of a number of times the one of the stored advertisements has been presented on the mobile device (Sakoda Col. 7 lines 46-51 & 65-67), a number of presentations that have been assigned to the mobile device, a number of requested presentations for the one of the stored advertisements and an expiration time for the one of the stored advertisement. (Hamano Fig. 2, Page 2 [0028] and Page 3 [0032-0033])

Regarding claim 29, the limitations of claim 29 are rejected as being the same reason set forth above in claim 13.

Regarding claim 30, Sakoda in view of Van Erlach and Hamano teaches the central advertising server (Sakoda Fig. 1 [10]) assigns an expiration time for the selected new advertisement and transmits the assigned expiration time to the mobile device. (Hamano Fig. 2, Page 2 [0028] and Page 3 [0032-0033])

Regarding claim 31, Sakoda in view of Van Erlach and Hamano teaches the central advertising server is adapted to select the new advertisement according to a priority weighting procedure. (Hamano Page 4 [0042] & Page 6 [Claim 12])

Regarding claim 32, Sakoda in view of Van Erlach and Hamano teaches the priority weighting procedure relates to at least one of a remaining number of requested presentations for each advertisement and a time remaining until an expiration time for each advertisement. (Hamano Page 3 [0032-0033], Page 4 [0042] & Page 6 [Claim

12])

Regarding claim 33, Sakoda in view of Van Erlach and Hamano teaches the central advertising server (Sakoda Fig. 1 [10]) can determine if a new expiration time for a current advertisement is available if at least one new advertisement is not available and transmit a new expiration time for the current advertisement if a new expiration time for the current advertisement is available. (Hamano Page 2 [0028], Page 3 [0032-0033], page 4 [0042] & Page 6 [Claim 12])

Regarding claims 37-39, the limitations of claims 37-39 are rejected as being the same reason set forth above in claim 8-10.

Claims 5 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakoda in view of Van Erlach as applied to claims 4 and 21 above, and further in view of Sanctis et al. (US-2005/0131837 hereinafter, Sanctis).

Regarding claim 5, Sakoda in view of Van Erlach teaches the limitations of claim 4 above, but differs from the claimed invention by not explicitly reciting the application comprises a Binary Runtime Environment for Wireless application.

In an analogous art, Sanctis teaches a method of advertising product information to a mobile device (Abstract) that includes data that is downloaded of data by an application running on the mobile device (Sanctis Page 6 [0051]), wherein the application comprises a Binary Runtime Environment for Wireless application. (Sanctis Page 5 [0040]) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to be motivated to implement the method of advertising on a

mobile device of Sakoda in view of Van Erlach after modifying it to incorporate the BREW application of Sanctis since mobile devices obviously require an operating system and BREW can be considered one option available as an operating system for third generation cellular.

Regarding claim 22, Sakoda in view of Van Erlach and Sanctis teaches the application initiates the wireless data communication. (Sanctis Page 5 [0037-0038])

Regarding claim 23, Sakoda in view of Van Erlach and Sanctis teaches the wireless data communication involves data needed by the application to perform an operation requested by a user of the mobile device. (Sanctis Page 4 [0033-0035])

Regarding claim 24, Sakoda in view of Van Erlach and Sanctis teaches the application runs on a Binary Runtime Environment for Wireless platform. (Sanctis Page 5 [0040])

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakoda in view of Van Erlach as applied to claim 1 above, and further in view of Rakavy et al. (US-5,913,040 hereinafter, Rakavy).

Regarding claims 14 and 15, Sakoda in view of Van Erlach teaches the limitations of claim 1 above, but differs from the claimed invention by not explicitly reciting the stored advertisement comprises a bitmap.

In an analogous art, Rakavy teaches a method and system for providing advertisements to a user's computer by transmitting information in the background (*i.e.* prior to being needed and without disturbing the user [Abstract]) that includes storing

advertisements as bitmaps or animations (Col. 7 lines 13-29), wherein it is obvious to one of ordinary skill in the art that if a bitmap has multiple frames and they are shown sequentially, the user is viewing an animation. At the time the invention was made, it would have been obvious to one of ordinary skill in the art to be motivated to implement the method of advertising of Sakoda in view of Van Erlach after modifying it to incorporate the use of bitmaps and animations for advertisements of Rakavy since bitmaps can be highly compressed (which is important because memory will be limited on a mobile device) and bitmaps can easily be linked together to provide a simple animation.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sakoda in view of Van Erlach as applied to claim 17 above, and further in view of Levin et al. (US-2002/0128908 hereinafter, Levin).

Regarding claim 25, Sakoda in view of Van Erlach teaches receiving responses from the mobile terminals regarding feedback information about how may times advertisements were displayed (Sakoda Col. 7 lines 46-51 & 65-67), which obviously motivates the service provider to create, maintain and analyze statistical information regarding expected fees and advertisement views/success rates of advertisements because an advertiser's views/success rate would be the best selling point for getting new customers. An example of such a well known method for data reporting can be seen in Levin Fig. 5.

(10) Response to Argument

In response to the Appellant's argument regarding claims 1, 17 and 34 that *the Examiner has taken an unreasonable characterization of Van Erlach and overbroad interpretation of claim 1* (Pages 7-8 and 10), the Examiner respectfully disagrees.

The first claim limitation at issue is "determining a time required to complete the wireless communication" which directly correlates to Sakoda teaching "that when providing the advertising information during the waiting time, the remaining time until the completion of the information transfer is also provided to the user". (Col. 5 lines 55-58) Further, the Appellant states "the claimed determined time in claim 1 is the actual time required to complete the wireless communication involving a mobile device, such as downloading a file to the mobile device" (Appeal Brief Page 8 Lines 2-4), which also correlates to Sakoda teaching "the user views the advertising information during the waiting time for the requested information to be downloaded". (Col. 8 lines 59-61)

The second claim limitation at issue is "selecting one of the stored advertisements to present on the mobile device during at least a portion of the wireless communication if the determined time is longer than a threshold time. Sakoda does teach selecting and displaying advertisements to a user of a mobile device during the waiting time of a wireless communication to be completed (Col. 8 lines 55-67 and Col. 10 lines 55-57), but Sakoda does not explicitly recite selecting an advertisement if the determined time is longer than a threshold time.

The Examiner then turned to the analogous art of Van Erlach which is directed to providing user specific content to wireless mobile devices. (Van Erlach Page 1 [0007]) Van Erlach teaches that ads are selected "from a database on an ad server whose

designated target audience, <u>time slot</u>, television show characteristics and other parameters match those of input" (Page 2 [0011]) which leads one of ordinary skill in the art to recognize that one of the selection criteria in determining which ad to show is based on the amount of time available in the time slot. Further, Van Erlach includes the additional ability to compress or alternatively decompress ads so that they can be made to "fit" into the available time slot. Therefore, Van Erlach teaches the ability to select a stored advertisement that has a runtime that is longer than the time slot and an advanced ability not claimed by the Appellant of being able to adjust the runtime of the advertisement to more closely equal the time slot.

The Examiner views Van Erlach's time slot (which has a fixed time length) as equating to the "threshold time" (which is a fixed time that is long enough to run an advertisement) and the ability to compress or decompress the ad's runtime to fit and fill the time slot as equating to the "determined time", which can be longer than the time slot since the ad's runtime might have to be compressed in time. Further, the analogy also fits if the "determined time" is equated to the time slot and the ad's runtime is equated to the "threshold time", since Van Erlach teaches that an ad's runtime can be decompressed to fill the time slot (*i.e.* the determined time is longer than the threshold time because the time slot is longer than the ad's runtime). The Examiner is not stating that Van Erlach is "determining a time required to complete the wireless communication", since that is taught by Sakoda as explained above.

Further, the Examiner believes that it is well within the scope of one of ordinary skill in the art to recognize that if the advertisement's runtime is much longer than the

available time slot and would not be an effective advertisement even when compressed (because too much information would have to be cut), that the intelligent router in Van Erlach would not try to compress the advertisement and would instead search for another advertisement to display. The Examiner believes it is well within the scope of one of ordinary skill to recognize that the amount of compression and decompression that can occur to an advertisement would have an upper and lower boundary in order to still be an effective advertisement.

As a separate point, the Examiner believes "selecting one of the stored advertisements to present on the mobile device during at least a portion of the wireless communication" is not a positive recitation of the limitation because the stored advertisement is selected "if the determined time is longer than a threshold time". Further, the Appellant argues that "Only if that determined time is longer than the threshold time, is an advertisement selected" (Page 8), however the claim does not recite "only if". The Examiner believes the Appellant is improperly interpreting the claims too narrowly.

In response to the Appellant's argument that *For the Office's claim construction to be valid, the Office must show that Van Erlach selects an ad if the "ability to compress or decompress the ad to fit the time slot" is longer than the "time slot" is incomprehensible, technically illogical and untenable* (Page 9), the Examiner respectfully disagrees.

Van Erlach teaches that an advertisement's runtime can be shortened (*i.e.* compressed) in order to fit within a time slot. (Page 2 [0011]) Further, Van Erlach

teaches that an ad's runtime can be decompressed to fill the time slot. (Page 2 [0011])

The Examiner is confused as to why this is incomprehensible, technically illogical and

untenable since Van Erlach explains the ad's time length is compressed or

decompressed digitally in order to fit in the time slot. (Page 2 [0011])

In response to the Appellant's argument regarding claim 34 that Sakoda in view

of Van Erlach does not teach *presenting one or more of a rotation of the stored*

advertisements (Pages 10-11), the Examiner respectfully disagrees.

Sakoda teaches "the successively viewed advertisements, that is, the

advertisements viewed during initialization of the terminal 30_j and the advertisement

viewed during the waiting time for downloading in the example shown in Fig. 5, become

different" (Col. 9 lines 9-13) as meeting the Appellant's claimed "presenting one or more

of a rotation of the stored advertisements".

Further, the rejection of claims 35-36 is maintained in view of the further

explanations above with respect to claim 34.

In response to the Appellant's argument to the *priorities assigned in Sakoda are*

not based on the above claimed condition of "if the determined time is longer than a

threshold time" (Page 11), the Examiner respectfully disagrees.

The Appellant is improperly taking a piecemeal analysis of the references.

Sakoda's teachings include displaying the time remaining until a requested wireless

communication is completed (Col. 8 lines 55-58), displaying the advertisements during

the waiting time (Col. 8 lines 59-61) and stopping the advertisements once the wireless

communication wait time has finished. (Col. 8 lines 62-67) The Examiner is improving

upon Sakoda's opened ended ability to determine which ad should be selected. (Col.
10 lines 55-57) The Examiner is relying upon Van Erlach to teach that ads are selected
based on the time available in the "time slot" and other parameters matching the user's
interest, (Page 2 [0011]) which leads one of ordinary skill in the art to recognize that one
of the selection criteria in determining which ad to show is based on the amount of time
available in the time slot.

Van Erlach includes the additional ability to compress or alternatively
decompress ads so that they can be made to "fit" into the available time slot. The
Examiner views Van Erlach's time slot to equating to the "threshold time" and the ability
to compress the ad to fit and fill the time slot as equating to the "determined time"
(because the ad is longer than the time slot). Further, the analogy also fits if the
"determined time" is equated to the time slot and the ad's runtime is equated to the
"threshold time", since Van Erlach teaches that an ad's runtime can be decompressed
to fill the time slot (*i.e.* the determined time is longer than the threshold time because
the time slot is longer than the ad's runtime).

In response to the Appellant's argument regarding claim 26 that *The boot up and
wake up process in Hamano are not related to any wireless communication and thus
the ads in Hamano are not displayed "during at least a portion of the wireless...." and
"wherein the advertising application on a mobile device presents the new advertisement
during the delay if the delay is longer than a threshold time"* (Pages 11-12), the
Examiner respectfully disagrees.

The Examiner has not cited Hamano for teaching either of the cited portions

above. Rather, the Examiner is relying upon Van Erlach to teach that ads are selected based on the time available in the "time slot" and other parameters matching the user's interest, (Page 2 [0011]) which leads one of ordinary skill in the art to recognize that one of the selection criteria in determining which ad to show is based on the amount of time available in the time slot. Van Erlach teaches the additional ability to compress or alternatively decompress ads so that they can be made to "fit" into the available time slot. Further, the analogy also works when the "determined time" from claim 1 is considered a "delay" as in claim 26. The Examiner views Van Erlach's time slot as equating to the "threshold time" and the ability to compress the ad to fit and fill the time slot as equating to the "delay time" (*i.e.* the delay time is longer than the threshold time which is the same as Van Erlach teaching the ad is longer than the time slot and requires compressing). Further, the analogy also fits if the "delay time" is equated to the time slot and the ad's runtime is equated to the "threshold time", since Van Erlach teaches that an ad's runtime can be decompressed to fill the time slot (*i.e.* the delay time is longer than the threshold time because the time slot is longer than the ad's runtime and therefore requires time decompression).

Finally, as a separate point, the Examiner believes "the advertising application on a mobile device presents the new advertisement during the delay" is not a positive recitation of the limitation because the stored advertisement is selected "if the delay is longer than a threshold time". Further, the Examiner believes that "transmit a selected new advertisement to the mobile device" is not a positive recitation of the limitation because the transmit occurs "if at least one new advertisement is available". If there is

not a new advertisement available, then there is not a step of "transmit a selected new advertisement" or "presents the new advertisement during the delay if the delay is not longer than a threshold time".

Therefore, the rejection of claims 8-13, 16, 18-20, 26-33 and 37-39 are maintained in view of the above explanation.

In response to the Appellant's arguments regarding claims 5 and 22-24 that *the addition of Sanctis fails to alleviate the deficiencies of Sakoda and Van Erlach* (Page 12), the Examiner respectfully disagrees.

The Appellant's alleged deficiency has been responded to above with respect to claim 1 and will not be repeated here again.

In response to the Appellant's arguments regarding claims 14-15 that *the addition of Rakavy fails to alleviate the deficiencies of Sakoda and Van Erlach* (Page 13), the Examiner respectfully disagrees.

The Appellant's alleged deficiency has been responded to above with respect to claim 1 and will not be repeated here again.

In response to the Appellant's arguments regarding claim 25 that *the addition of Levin fails to alleviate the deficiencies of Sakoda and Van Erlach* (Page 13), the Examiner respectfully disagrees.

The Appellant's alleged deficiency has been responded to above with respect to claims 1 and 17 and will not be repeated here again.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/MATTHEW SAMS/

Examiner, Art Unit 2617

Conferees:

/Lester Kincaid/

Supervisory Patent Examiner, Art Unit 2617

/Rafael Pérez-Gutiérrez/

Supervisory Patent Examiner, Art Unit 2617